

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 14, 2006 (the "Office Action"). Claims 8, 20-24 and 46-67 were cancelled in a previous amendment. Claims 16-18, 28, and 38 have been cancelled without prejudice in the present amendment. Claims 1-7, 9-15, 19, 25-27, 29-37, 39-45, and 68-78 remain for consideration.

Amendments

Independent claim 1 (and corresponding dependent claim 13), independent claim 15 (and corresponding dependent claim 19), and independent claims 25, 34, 68 and 72 have been amended in the present amendment to further emphasize patentably distinguishing features of the invention and to provide Applicants with the full scope of protection to which they deem their invention is entitled. The amendments are supported by the prior presented claims, the specification (for support regarding claim 25, please see e.g., specification page 4, paragraph [0012], page 14, paragraph [0052]). Applicants submit that these amendments present no new matter.

Specifically, independent claims 1 and 15 have been amended to recite a fence system comprising a "horizontal mounting

surface," a "plurality of individual members attached to the horizontal mounting surface" and "a plurality of individual fasteners for attaching the plurality of individual members to the horizontal mounting surface, wherein each individual fastener passes through the front surface and back surface of the individual member into the horizontal mounting surface." Claim 15 has also been amended to recite that the "front surface and back surface of the individual members are embossed with a pattern."

Independent claim 25 has been amended to recite picket comprising fiber cement for a fence, wherein the picket "has a pattern formed on the front and back surfaces of the picket, the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers."

Independent claim 34 has been amended to recite, among other things, a fence system "wherein each individual picket is spaced from another of the individual pickets by a distance of between about $\frac{1}{2}$ and 1 inch."

Independent claim 68 has been amended to recite an elongated member having a "front surface and a back surface, and made of fiber cement, wherein the elongated member has a pattern

formed on the front surface and back surface, the pattern being applied to the front surface and to the back surface substantially simultaneously by two embossing rollers."

Independent claim 72 has been amended to recite a fence picket comprising an elongated member made of a "plurality of layers of fiber cement, said elongated member not exhibiting any substantial visible separation of the plurality of fiber cement layers."

Section 103 Rejections

In the Office Action, the Examiner rejected Claims 1-7, 9-19, 25-45 and 68-78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 3,801,072 to Newberry, Jr. ("Newberry") in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al ("Gleeson"). With respect to the rejections as applied to Claims 16-18, 28, and 38, these claims have been cancelled and as such, Applicants submit that the rejections with respect to these claims are rendered moot.

Applicants respectfully submit that neither the Newberry or Gleeson references, taken individually or in combination, teaches or makes obvious, the fence system and fence pickets as presently recited in Applicants' claims. Newberry's unitary fence panel is formed from a mold (i.e., a negative impression

of an existing fence which duplication is desired- see Col. 2, lines 18-20). The resulting fence structure (produced from the mold) does not contain individual pickets, but rather is a fiberglass panel sheet.

With respect to Applicants' claims 1 and 15 as amended, Newberry does not disclose or suggest a fence system having a "horizontal mounting surface" and a "plurality of individual members attached to the horizontal mounting surface", and a "plurality of individual fasteners for attaching the plurality of individual members to the horizontal mounting surface, wherein each individual fastener passes through the front surface and the back surface of the individual member into the horizontal mounting surface," as recited in Applicants' amended claim 1 and 15.

Rather, the sheet in Newberry is erected using tubular supporting members positioned along the back of the panel and permanently and rigidly bonded to the panel by a strip of fiberglass mat saturated with polyurethane (see Col. 3, lines 36-38; 66-68; Col. 4, lines 1-3). Lug pins are then inserted into the tubular support members (see FIGURE 3), which are themselves secured to sides of the vertical posts 30, which allows for erection of the panel (see Col. 4, lines 19-22).

There is no suggestion or motivation to modify Newberry, or combine Newberry with Gleason, to arrive at Applicants' claims.

The only reference in Newberry to a fastener passing through the panel is if two (2) panels constructed such that the ends of the panels terminate to make the appearance of a stave of one-half width (see FIGURE 5) are combined. When such panels (containing a one-half width stave) are joined together the two panels (when joined) have the appearance of forming one complete vertical stave, such that the "uniformity of the completed fence will not be interrupted." (see Col. 4, lines 23-27). Newberry discloses that these panels may be further joined together by a separate stave nailed to the vertical post through the fiberglass panel directly over the junction (see Col. 4, lines 27-30). No fastener, however, is nailed through the panel and into the horizontal support tubes (there is no motivation or suggestion to perform such an operation, especially in light of the elaborate connection scheme of brackets/tubular supports that must be employed to erect the fence panel).

With respect to Applicants' present claims 25 and 68, there is no suggestion or motivation to prompt one of skill in the art to modify Newberry or combine Newberry with Gleason to arrive at Applicants' claims which recite a fiber cement picket having a

pattern "formed on the front surface and back surface of the picket, the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers." While Newberry discloses that both sides of the panel can be replicated through use of multiple molds, there is no disclosure or suggestion in Newberry or Gleason of a fence panel having a pattern "formed on the front surface and back surface of the picket, the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously by two embossing rollers," as is recited in Applicants' amended claims 25 and 68. Nor do the cited references, even if combined, recite all of Applicants' claim limitations.

With respect to Applicants' present claim 34, there is no suggestion or motivation to prompt one of skill in the art to modify Newberry or combine Newberry with Gleason to arrive at Applicants' claim 34, which recites a fence system comprising a plurality of individual pickets, "wherein each individual picket is spaced from another of the individual pickets by a distance of between about $\frac{1}{2}$ and 1 inch." First and foremost, the Newberry fence panel is produced from a mold, and as such, the fence panel is "unitary" and does not consist of multiple

individual staves (see Col. 4, lines 45-52). In addition, while Newberry discloses that the finished panel may be formulated to replicate the original junctions in the model fence (i.e., which show up as a distinct grain line - see Col. 4, lines 49-51), due to the molding process, Newberry cautions that the "junctions between the individual components [of the to-be-modeled fence] should be relatively **continuous.**" See Col. 4, 47-49.

With respect to Applicants' present claim 72, there is no motivation or suggestion in the references, either alone or in combination, for a fence picket comprising an "elongated member made of a plurality of layers of fiber cement," said elongated member "does not exhibit any substantial visible separation of the plurality of fiber cement layers" as is recited in Applicants' claim 72 as amended.

With respect to each of the claim rejections over Newberry in view of Gleeson, while Gleeson discloses a fiber cement building material having low density additives and cellulose fibers, Gleeson does not disclose or suggest a fiber cement material for use in a fence system or as a fence picket as presently recited in Applicants' claims, and there is no suggestion or motivation to make the combination. Moreover, even if the references are combined, the combined references do

not teach or suggest all of Applicants' claim limitations as recited above.

For these reasons, Applicants respectfully request that the Examiner withdraw the rejections of the claims under § 103.

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and Applicants earnestly seek such allowance of Claims 1-7, 9-15, 19, 25-27, 29-37, 39-45, and 68-78. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' attorney at 214.999.4487. Applicants, through their attorney, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843.1082. In the event that any additional time is

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needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

This is intended to be a complete response to the Office Action mailed July 14, 2006.

Please direct all correspondence to the practitioner listed below at Customer No. 60148.

Respectfully submitted,



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